



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/510,124

10/04/2004

Anders Dahlberg

HPX0088-PCT

6608

909

7590

05/19/2009

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

05/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,124	Applicant(s) DAHLBERG, ANDERS	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response filed on September 12, 2008 has been entered.

Drawings

2. The drawings were received on September 12, 2008. These drawings are acceptable.

Claim Objections

3. Claims 14-17 stand objected to because of the following informalities:

In claim 14, line 2, the recitation "a cylindrical recess" is not sufficiently clear as to whether it is further defining the recess set forth in claim 13 or is defining another recess.

In claim 20, line 3, the recitation "a cylindrical recess" is not sufficiently clear as to whether it is further defining the recess set forth in claim 13 or is defining another recess.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 2nd paragraph

4. Claim 19 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, line 2, "said material thickness" is vague as to which one.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Initially, it is noted that claims 18, 19 and 21 were previously rejected under 35 USC 103 as lacking certain claim limitations. However, upon careful reconsideration, it is respectfully submitted that the base reference in fact discloses all of the claim limitations and thus the subject claims should be rejected under 35 USC 102(b). Further, it is respectfully submitted that such a prior art rejection is not considered to be a new grounds of rejection since it has been held that anticipation is the "epitome of obviousness," *In re Kalm*, 378 F.2d 959, 962 (CCPA 1967).

7. Claims 18, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindell, pn 4,470,330.

Lindell discloses a device with every structural limitation of the claimed invention including:

a striking unit (e.g., 20);

a tool housing (e.g., 25, 27);

a damper unit (e.g., 53, 55);

a movable crosscutting tool (e.g., 26; or the cylindrical tool within component 26)

and a fixed crosscutting tool (e.g., the cylindrical too within component 27);

said tool housing comprising a solid base element (e.g., 25, 27) with a horizontally extending circular recess (e.g., within component 27) for receiving said fixed crosscutting tool (e.g., as shown in Figures 2 and 3, the circular tool within component 27);

said recess having a supporting surface (e.g., the cylindrical surface against which the cylindrical tool within 27 abuts) with support material for withstanding impact acting in a transverse direction on said fixed crosscutting tool, the supporting surfaces being curved and having a radius, and

wherein, in the direction of impact, a material thickness of said solid base element measured from said supporting surface (e.g., the cylindrical surface within component 27) to an upper end surface of said base element (e.g., the topmost surface shown in Fig. 2, above numeral 36) is greater than a transverse material thickness of said base element (e.g., as stated in the previous Office action, the portion of the base element between 53 and the rightmost or leftmost side; or the portion of the base element measured from the cavity in which 57 is located to the rightmost side of the base element);

[claim 19] wherein an extent of said recess in a direction of impact is less than said material thickness in a direction of impact (e.g., as shown in Fig. 2);

[claim 21] wherein said base element further comprises a part with a curved supporting surface (e.g., the cylindrical recess within component 26), and wherein said movable crosscutting tool (e.g., the cylindrical tool within component 26) has curved edge surfaces in contact with said curved supporting surface of said base element, said curved edge surfaces having a substantially similar radius as said curved supporting surface.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Initially, it is noted that claims 20 was previously rejected under 35 USC 103 as lacking certain claim limitations. However, upon careful reconsideration, it is respectfully submitted that the base reference in fact discloses all of the claim limitations. Further, it is respectfully submitted that such a prior art rejection is not considered to be a new grounds of rejection since it has been held that anticipation is the "epitome of obviousness," *In re Kalm*, 378 F.2d 959, 962 (CCPA 1967).

10. Claims 13-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindell, pn 4,470,330 in view of Funke, pn 3,391,591 and Winters, pn 1,318,249.

Lindell discloses a device with almost every structural limitation of the claimed invention including:

- a striking unit (e.g., 20) comprising a striking piston;

- a tool housing (e.g., 25, and alternately 25, 27);

- a damper unit (e.g., 53, 55);

- a movable crosscutting tool (e.g., 26 and/or the circular tool in the center thereof) movably arranged within said tool housing;

- a fixed crosscutting tool (e.g., 27 and/or the circular tool in the center thereof) fixedly arranged within said tool housing;

- said striking piston arranged to administer a force to the movable crosscutting tool;

- said fixed crosscutting tool arranged to exert a detaining force upon the workpiece;

- said damper unit constructed and arranged to brake the striking motion of said movable crosscutting tool, and

- wherein the tool housing has at least two supporting surfaces for positioning said movable crosscutting tool, wherein a recess (e.g., as shown in Fig. 3 between the surfaces of 32 through which 30 extends) is constructed and arranged between said supporting surfaces to provide space for movement of said striking piston therein;

[portion of claim 14] wherein said recess is designed for arrangement of said fixed crosscutting tool inside said tool housing (e.g., as shown in Figs. 2 and 3).

[claim 15 (from 14)] wherein said recess is disposed in a homogenous base element belonging to said tool housing (e.g., as shown in Figs. 2 and 3);

[claim 16 (from 15)] wherein an axially displaceable adjusting mechanism (e.g., 38) is disposed coaxially with said cylindrical recess for axially adjustable positioning of said fixed crosscutting tool inside said recess;

[claim 17 (from 15)] wherein a supporting member for said damper unit is designed to be anchored directly to said base element;

[claim 20] wherein said fixed crosscutting tool (e.g., the tool disposed within component 27 as viewed in Fig. 2) has curved edge surfaces (i.e., in the same manner as the tool disposed within component 26 as viewed in Figs. 2, 2, 3 and 5) that are fitted into a cylindrical recess of said tool housing (e.g., 25, 27), said curved edge surfaces having a substantially similar radius as said cylindrical recess.

Lindell lacks:

[from claim 13] said supporting surfaces being curved and having a same radius, and wherein said movable crosscutting tool has curved edge surfaces in contact with said curved supporting surfaces of said tool housing, said curved edge surfaces having a substantially similar radius as said curved supporting surfaces to assist in alignment of said tool device;

[from claim 14] wherein the tool housing is further provided with a cylindrical recess having a same centre line and said same radius as said supporting surfaces.

Regarding claim 13, Lindell discloses a movable cutting tool having curved surfaces but lacks corresponding curved surfaces on the tool support. However, such corresponding/complementary surfaces are old and well known in the art and provide various well known benefits including reducing play between the support and tool. Funke discloses one example of such complementary surfaces such as for tool 23. Therefore, it would have been obvious to provide such support surfaces on the device of Lindell to gain the well known benefits including that described above.

Regarding claim 14, such cylindrical surfaces for fixed tools are old and well known in the art and provide various well known benefits including simple manufacture. Winters discloses one example of such a cylindrical configuration for fixed tools. Therefore, it would have been obvious to provide such support surfaces on the device of Lindell to gain the well known benefits including that described above.

Response to Arguments

11. Applicant's arguments filed September 12, 2008 have been fully considered but they are not persuasive.

In the third paragraph on page 7 of the subject response, applicant argues that the objection should be withdrawn because the recitations that are set forth to define the recesses are different. The Examiner respectfully maintains that it is not sufficiently

clear as to whether the additional recitations are intended to define the existing recess or to define another such recess, and it is suggested, for example, in claim 13, line 15, to change "a recess" to --a piston access recess--, and in claim 14, line 2 to change "a cylindrical recess" to --a cylindrical fixed tool recess-- or the like.

In the fifth paragraph on page 8 of the subject response, applicant argues that the recitation to "a material thickness" is sufficiently clear. The Examiner respectfully disagrees, particularly since it is not clear as to whether the recitation "in a direction of impact" further defines the thickness or is intended to refer to that previously recited (although the recitation "said material thickness in a direction of impact" lacks positive antecedent basis), and it is suggested in claim 18, line 12 to change "a material thickness" to --a longitudinal material thickness-- or --a vertical material thickness-- or the like, and in claim 19, line 2 to change "said material thickness" to --said longitudinal material thickness-- or --said vertical material thickness-- or the like.

On pages 9 and 10 of the subject response, applicant argues that:

"Applicant submits that there is no motivation to combine the cited features of Lindell and Funke. Specifically, the cited portions of Funke disclose a knife plate 23a with shapes to assist in guiding the insertion of rods into a rod shearing device. None of the cited portions of Funke disclose or remotely suggest a 'tool housing [having] at least two supporting surfaces for positioning said movable crosscutting tool, said supporting surfaces being curved and having a same radius' and a 'movable crosscutting tool [having] curved edge surfaces in contact with said curved supporting surfaces of said tool housing, said curved edge surfaces having a substantially similar radius as said curved supporting surfaces to assist in alignment of said tool device' (emphasis added) as recited in

claim 13. At most, the cited portions of Funke disclose a stationary plate 2 with guide surfaces for a rod steel sheer 23 on its side. Funke does not, however, disclose a movable crosscutting tool with curved edge surfaces in contact with curved supporting surfaces of a tool housing as recited in claim 13.”

The Examiner respectfully disagrees with applicant's analysis. It is respectfully pointed out that Lindell '330 discloses the movable crosscutting tool having the claimed curved edge in the form of the lower left and right hand convex corners of the tool 26 as viewed in Figure 3, the curved convex edges being in the form of radiused corners of the tool. In this regard, the only features lacking in Lindell '330 are corresponding radiused concave corners formed by the support surface at the lower left and right hand corners of the opening that accommodates tool 26. Rather, Lindell '330 discloses an alternate configuration of squared corners (i.e., at the intersection where the rectangular features extend upwardly from feature 32 on both sides of the tool 26). However, the Examiner respectfully maintains that to provide radiused corners is old and well known in the art, and more generally in the mechanical arts, wherein such radiused corners provide various well known benefits including those described in the prior art rejection. Further, such radiused corners are often provided to gain additional benefits such as stress reduction so as to prevent or reduce the possibility of stress fractures in the form of cracks in the highly stressed corner areas. Thus, it is respectfully submitted that to modify Lindell '330 by replacing the square concave corners with radiused concave corners would be well within the level of ordinary skill in the art and therefore an obvious modification of Lindell '330. It is noted that the teaching reference to Funke was provided to show that such radiused convex corners are old and well known in the art.

Further, in the second and third paragraphs on page 10 of the subject response, applicant argues that Lindell and/or the combination of Lindell and Funke further fail to disclose "a recess...constructed and arranged between said curved supporting surfaces to provide space for movement of said striking piston therein" as recited in claim 13."

Applicant then argues that:

"More specifically, it is noted that the ram 20 of Lindell is designed to impact block 30. See, e.g., Lindell at column 2, lines 40-54 and column 4, lines 21-24, and Figures 2 and 3. Thus, the ram 20 can not move into the space or recess between the surfaces of 32 through which 30 extends."

The Examiner respectfully disagrees with applicant's analysis. It is emphasized that the subject limitation, which is:

"wherein a recess is constructed and arranged between said curved supporting surfaces to provide a space for movement of said striking piston therein,"

defines the location (i.e., between the curved supporting surfaces) and the size to accommodate and intended use (i.e., for movement of the striking piston therein). It is respectfully submitted that there is no recitation/requirement set forth that positively recites that the piston extends into this recess. It is respectfully submitted that, as viewed in Fig. 3 of Lindell '330, the ram 20 includes an arcuate upper surface that is such a size that it is fully capable of at least partially entering the space/recess in feature 32.

On pages 12-13 of the subject response, applicant argues that the prior art does not teach or suggest the invention of claims 18, 19 and 21. The Examiner respectfully disagrees with applicant's analysis and submits that the prior art to Lindell '330

discloses every structural limitation of the claimed invention at least in the manner described in detail in the corresponding prior art rejection above.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
May 15, 2009